



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/794,154	02/03/97	SCHWARTZ	A SWTZ110464

34M1/1230
CHRISTENSEN O'CONNOR JOHNSON & KINDNESS
1420 FIFTH AVENUE
SUITE 2800
SEATTLE WA 98101

EXAMINER

NERBUN, P

ART UNIT	PAPER NUMBER
----------	--------------

3408

20

DATE MAILED:

12/30/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks



UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Office

ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS

Washington, D.C. 20231

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

DEC 3 1997

Paper No. 1820

Application Number: 08/794,154

Filing Date: Feb. 3, 1997

Appellant(s): Schwartz et al

Thomas D. Theisen

For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed Aug. 29, 1997.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

Art Unit: 3408

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The change is as follows: The final rejection (paper no. 15) states that claim 37 "does not comply with the requirements of 35 U.S.C. 112, second paragraph.". The brief does not contain any reference to this issue. See the fourth paragraph of section (13) hereinbelow for a further discussion of this matter.

(7) *Grouping of Claims*

Appellant's brief includes a statement that the patentability of claims 1, 2, 37, 40, 50, 59, and 61-63 is to be determined separately. This is construed to be equivalent to a

Art Unit: 3408

statement that these claims do not stand or fall together. Reasons for this statement are further provided as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

✓ 5,093,940	NISHIYAMA	3-1992
✓ 5,334,646	CHEN	8-1994
✓ 5,331,691	RUNCKEL	7-1994

No new prior art has been applied in this examiner's answer.

(11) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 2, 37, 38, 40, 41, 50, 58-60, 64, and 65 stand rejected under 35 U.S.C. 103 as being unpatentable over Runckel in view of Chen. The patent to Runckel discloses goggles having a frame 14, 16, 18, Fig. 1 including a transparent portion. A sealing pad 42 is designed to conform to the orbits of the user's eyes. To construct the goggles of Runckel with the sealing pad being formed from a gelatinous elastomer as suggested by Chen would have been obvious since Chen discloses that a gelatinous elastomer is a known material

Art Unit: 3408

and that it may be used in forming a large number of articles including those designed for "sport health care". (See column 2, lines 7-9.). For a further discussion of this motivation see the first paragraph of section (13) presented hereinbelow. Another reason that it would have been obvious for one having ordinary skill in the art to construct the sports goggles of Runckel with pad 42 being formed from a gelatinous elastomer is that Chen states that this material may be used in various optical devices, (See column 6, lines 58-61.). Again, please see the discussion that follows in the first paragraph of section (13). With regard to claims 2, 37, and 40, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select a gelatinous elastomer having a degree of compliancy within the range recited since it has been held that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 105 USPQ 233. The "general conditions of a claim" as used in *In re Aller* refer to those conditions which are not limited by degree. With regard to claim 1 of the instant application, such conditions would include goggles having a frame including a transparent portion and goggles having a sealing pad adjacent to the frame, said frame comprising a compliant and resiliently deformable gelatinous elastomer. Runckel and Nishiyama both disclose the "general conditions" of a pair of goggles having a frame including a transparent portion and goggles having a sealing pad adjacent to the frame, said sealing pad comprising a compliant and resiliently deformable material. Further Chen discloses the other "general condition" (viz. the particular material of a gelatinous elastomer having the properties

Art Unit: 3408

set forth by appellant). The workable range of pressure which produces the desired degree of compliancy could have been discovered by routine experimentation. *In re Aller* noted that such range finding experimentation was no more than the application of the expected skill of an engineer and further that failure to perform such experiments would show a want of the expected skill of the engineer. The range recited by appellant produces no new and unexpected result which is different in kind and not merely in degree from the results of the prior art. Appellant's disclosure states that the gelatinous elastomer must be compliant yet resiliently deformable (see page 5, lines 18-19 of appellant's specification). To that end, gelatinous elastomers having compressibility characteristics which conform to the recited range of pressures have been selected. The gelatinous elastomer of Chen is also compliant yet resiliently deformable. Note column 6, lines 28-36 of Chen which states that molded articles made from gelatinous elastomers possess the intrinsic properties of elastic memory enabling the articles to recover and retain their original moulded shape after many extreme deformation cycles. Thus, Chen discloses the same properties of a gelatinous elastomer as does appellant. With regard to claim 37, it would have been obvious to one having ordinary skill in the art to construct the goggle of Runckel with the sealing pad being formed from a gelatinous elastomer that is surrounded by a film as suggested by Chen (see column 7, lines 8-11) to provide protection against abrasion during use of the goggles. With regard to claim 59, it would have been obvious to one having ordinary skill in the art to removably attach the sealing pad to the

Art Unit: 3408

frame since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

Claim 37 contains the trademark/trade name "Kitecko Ultrasound Standoff Pad".

Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). Thus claim 37 stands as not complying with 35 U.S.C. 112, second paragraph. Note that the claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name.

Claims 61-63 stand rejected under 35 U.S.C. 103 as being unpatentable over Nishiyama in view of Chen. (Note that claim 61 is dependent on claim 1 and thus includes all of the limitations of claim 1.). The patent to Nishiyama discloses swimming goggles comprising a frame 10, Fig. 1A including a transparent portion adapted to cover the user's eyes, and a sealing pad 41 adjacent to the frame, said sealing pad comprising a compliant and resiliently deformable urethane or neoprene elastomer (see column 3, lines 1-2). To construct the goggles of Nishiyama with the sealing pad being formed from a gelatinous elastomer as suggested by Chen would have been obvious since Chen discloses that a gelatinous elastomer is a known material and that it may be used in forming a large number of

Art Unit: 3408

articles including those designed for "sport health care". (See column 2, lines 7-9.). As stated previously, please see section (13) for a further discussion of this motivation. Another reason that it would have been obvious for one having ordinary skill in the art to construct the sports goggles of Nishiyama with pad 42 being formed from a gelatinous elastomer is that Chen states that this material may be used in various optical devices, (See column 6, lines 58-61.). With regard to claim 61, it would have been obvious that Nishiyama's goggle as seen in Figure 4 would fit outside the orbits of the user's eyes since the rim 13, Figure 4 does not slope upwardly at an angle that would permit the goggles to comfortably fit within the user's eye orbit. See the sixth paragraph of section (13) hereinbelow for a further discussion of this matter. With regard to claim 62, note the frame 11, 12, 13, Figure 1A of Nishiyama may flex within the mask frame 20 since frame 11, 12, 13 can be rotated with respect to the mask frame 20 to enable adjustment so as to conform generally to the shape of the user's face (see col. 4, lines 40-43).

(12) *New Ground of Rejection*

This examiner's answer does not contain any new ground of rejection.

(13) *Response to argument*

On page 8, lines 1-5 of the brief, appellant states that the principal issue in this appeal can be characterized as follows: "Would the teaching in Chen suggest, to a person skilled in the art, the use of Chen's gelatinous elastomer as a replacement for the conformable pad described in Runckel under 35 U.S.C. 103?".

Art Unit: 3408

In answering this question, the examiner would first note that the conformable pad 42, Fig. 2 of Runckel's sports goggles is a sealing pad. Note column 2, lines 7-8 of Runckel's specification which states that "The swim goggle design of the present invention produces a seal around the user's eye...". The only difference between the goggles defined in claim 1 of the instant application and the goggles disclosed by Runckel is the material from which the sealing pad is made. Claim 1 of the instant application recites that material as being a gelatinous elastomer. Chen discloses that a gelatinous elastomer is a known material and that it may be used in forming a large number of articles including those designed for "sport health care". (See column 2, lines 7-9.). Thus, it would have been obvious to one having ordinary skill in the art to construct the sports goggles of Runckel with the sealing pad 42 being formed from a gelatinous elastomer since Chen states that this material is useful in forming articles designed for sport health care. (Note that Runckel's goggles are used in a sport health care application. In column 1, first paragraph, Runckel states that his invention "relates to protective eyegear for use in sports activities, particularly sports involving water contact where it is desirable to seal the eye in a chamber which is protected from the external aqueous environment.". In column 1, second paragraph, Runckel notes that potential irritants such as chlorine, are present in such an external aqueous environment. Thus, by providing protection from chlorine and other potential irritants, Runckel has designed his swim goggles for use in a sport health care application. Another reason that it would have been obvious for one having ordinary skill in the art to construct the sports

Art Unit: 3408

goggles of Runckel with pad 42 being formed from a gelatinous elastomer is that Chen states that this material may be used in various optical devices, (See column 6, lines 58-61.).

In this regard, it is noted that appellant presents a definition of the word "optical" on page 9, lines 16-18 of the brief. One such definition (viz. "designed to assist sight") applies to the sealing pad 42 of Runckel because the pad prevents the entry of chlorine which would assist a wearer in being able to see. Therefore, Chen's suggestion of using a gelatinous elastomer in an optical device would apply as a reason for using a gelatinous elastomer in forming Runckel's sealing pad.

On page 9, line 3 of the brief, appellant states that Chen does not suggest that his (gelatinous elastomer) material can be used as a "sealing pad". In this regard, note that while there must be motivation to make a claimed invention, there is no requirement that the prior art provide the same reason as the appellant to make the claimed invention. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972).

On page 11, lines 21-25 and on page 12, lines 1-14 of the brief, appellant presents arguments in support of dependent claim 2. Claim 2 defines the degree of compliancy of the gelatinous elastomer when a particular range of pressures is applied to the top surface thereof. In this regard, the examiner has cited *In re Aller*, 105 USPQ 233 which holds that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. The "general conditions of a claim" as used in *In re Aller* refer to those conditions which are not limited by degree. With regard to

Art Unit: 3408

claim 1 of the instant application, such conditions would include goggles having a frame including a transparent portion and goggles having a sealing pad adjacent to the frame, said frame comprising a compliant and resiliently deformable gelatinous elastomer. On page 12, in the penultimate paragraph, appellant states that "None of the cited art discloses the general conditions that must be met by a sealing pad." The examiner disagrees since Runckel and Nishiyama both disclose the "general conditions" of a pair of goggles having a frame including a transparent portion and goggles having a sealing pad adjacent to the frame, said sealing pad comprising a compliant and resiliently deformable material. Further Chen discloses the other general condition pertaining to the particular material of a gelatinous elastomer having the properties set forth by applicant. The workable range of pressure which produces the desired degree of compliancy could have been discovered by routine experimentation. *In re Aller* noted that such range finding experimentation was no more than the application of the expected skill of an engineer and further that failure to perform such experiments would show a want of the expected skill of the engineer. Further, it is noted that the range recited by appellant produces no new and unexpected result which is different in kind and not merely in degree from the results of the prior art. Appellant's gelatinous elastomer must be compliant yet resiliently deformable (see page 5, lines 18-19 of appellant's specification). To that end, gelatinous elastomers having compressibility characteristics which conform to the recited range of pressures have been selected. The gelatinous elastomer of Chen is also compliant yet resiliently deformable. Note column 6, lines 28-36 of Chen which states that molded articles

Art Unit: 3408

made from gelatinous elastomers possess the intrinsic properties of elastic memory enabling the articles to recover and retain their original molded shape after many extreme deformation cycles. Thus, Chen discloses the same properties of a gelatinous elastomer as does appellant.

On page 13, lines 7-15 of the brief, appellant argues for claim 37 by noting that while Chen does disclose providing a film surrounding a gelatinous elastomer, Chen provides no suggestion that the film may surround a gelatinous elastomer when used as a "sealing pad", as claimed by appellant in claim 37. Given the teaching that a gelatinous elastomer may be surrounded by a film, it would have been obvious to one having ordinary skill in the art to surround the gelatinous elastomer sealing pad of the formed goggles of Runckel or Nishiyama with such a film to provide protection against abrasion during use of the goggles. Once again it is noted that while there must be motivation to make a claimed invention, there is no requirement that the prior art provide the same reason as the appellant to make the claimed invention. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972).

Although appellant does not provide any particular argument relating to the examiner's statement in the final rejection that claim 37 does not comply with the requirements of 35 U.S.C. 112, second paragraph, it is noted that appellant had argued this matter in paper no. 6, filed August 16, 1996. In that paper, appellant stated that claim 37 was not indefinite due to the use of the trademark "KITECKO" because this trademarked product "is generally recognized in the medical field under its trademarked name, and is a relatively standardized product used routinely in ultrasound diagnosis and treatment for humans". As

Art Unit: 3408

stated earlier, a trademark identifies a source rather than a particular product. The trademark may identify a different product having different structural characteristics at some time in the future. Thus, a trademark cannot be used to identify a product having a particular structure even though that structure may *presently* be associated with the trademark.

On page 14, lines 3-6 of the brief, appellant argues for claim 59 by stating that none of the prior art discloses a means for removable attachment of the sealing pad to the frame. In this regard, it is noted that it would have been obvious to one having ordinary skill in the art to removably attach the sealing pad to the frame since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

On page 14, last paragraph and lines 1-4, appellant argues for claim 61 by stating that Nishiyama does not disclose a frame sized to fit outside the orbits of the user's eyes. Appellant notes that Nishiyama does not expressly state whether the goggles fit inside or outside the orbits of the user's eyes, but that a person skilled in the art, comparing Figure 2 of Nishiyama with Figure 4 of Runckel and recognizing that Runckel expressly discloses goggles that fit inside the orbits of the user's eyes, would conclude that the goggles of Nishiyama likewise fit inside the orbits of the user's eyes. The examiner disagrees. Runckel discloses that "in order to comfortably fit within the user's eye orbit, a sloping upwardly facing rim on the upper wall of each eyepiece forms an angle of at least forty degrees, preferably about sixty degrees, with the plane of the lens. The upper wall of the eyepiece is shallow enough so that

Art Unit: 3408

the lens can be positioned backward from the user's brow and forehead...Prior art goggle designs which fit extra-orbitally protrude beyond the user's facial plane...". Thus, it would have been obvious that Nishiyama's goggle as seen in Figure 4 would fit outside the orbits of the user's eyes since the rim 13, Figure 4 does not slope upwardly at an angle that would permit the goggles to comfortably fit within the user's eye orbit.

On page 15, first full paragraph, appellant argues for claim 62 by stating that the frame of Nishiyama is not flexible. The examiner disagrees. The frame 11, 12, 13, Figure 1A of Nishiyama may flex within the mask frame 20 since frame 11, 12, 13 can be rotated with respect to the mask frame 20 to enable adjustment so as to conform generally to the shape of the user's face (see col. 4, lines 40-43).

Finally, on page 15, last paragraph of the brief, appellant argues for claim 63 by stating that Nishiyama does not disclose a frame that consists of a thin sheet of transparent material. The examiner disagrees. In column 4, lines 10-16, Nishiyama states that the lens unit 11 may be combined with tubular portion 12 and made from colored transparent cellulose acetate. Thus, the frame which includes lens unit 11 and tubular portion 12 is transparent. Moreover, the frame 11, 12, 13, Fig. 4 in Nishiyama is shown to be thin (relative to the thicker pad 41, Fig. 4).

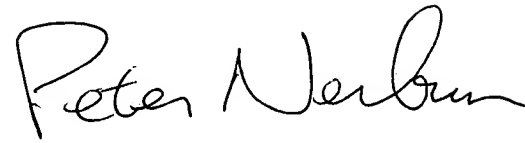
Serial Number: 08/794,154

Page 14

Art Unit: 3408

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

A handwritten signature in black ink that reads "Peter Nerbun". The signature is written in a cursive style with a large, looping "P" and a trailing flourish.

**PETER NERBUN
PRIMARY EXAMINER
GROUP 3400**

Peter Nerbun
December 24, 1997

Christensen O'Conner Johnson & Kindness
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101